

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed January 25, 2007. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1, 3, 5, 6, and 8-11 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Casey, et al.* ("Casey," U.S. Pat. No. 6,452,695). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Casey reference.

#### **A. The Casey Disclosure**

Casey discloses a system and method for enabling an image input device and a printer to operate as a digital copier. *Casey*, Patent Title. The system includes an "adapter device 100" that interconnects a printer 200 with an image input device 300. *Casey*, column 2, lines 55-62. The architecture of the adapter device is described by Casey in relation to Figure 2 and columns 3-5.

The adapter device includes a central processing unit or "processor" 140, memory 130, an I/O controller 120, and a control panel 110. Casey, column 3, lines 13-33. The control panel 110 comprises buttons 112 and a display 114. Casey, column 3, lines 35-40. As is described by Casey, the adapter device is "preferably packaged such that all of the components, with the exception of the control panel 110, are contained within a housing *or on a relatively compact peripheral card device*". Casey, column 4, line 65 to column 5, line 1 (emphasis added). Therefore, Casey's adapter device comprises an independent hardware component that can be used in conjunction with a printer and an image input device.

In addition to the above-described configuration, Casey discloses that the adapter device can be "integrated within a printer 200 or within an image input device 300 to enable direct connection between the peripheral devices (without the need for a host computer) thereby imparting the capability of the digital copier operation described herein." Casey, column 5, lines 17-21.

## B. Applicant's Claims

Independent claim 1 provides as follows (emphasis added):

1. A system for improving the performance of a plurality of peripheral devices, comprising:
  - a first peripheral device comprising a first software component and having a first functionality; and
  - a second peripheral device *coupled to the first peripheral device via a network*, the second peripheral device comprising a second software component and having a second functionality, the second peripheral

device being coupled to the first peripheral device without being directly connected to an intermediate computing device positioned along the communication path between the peripheral devices, the first and second peripheral devices together performing a third functionality in addition to the first and second functionalities;

wherein the first peripheral device comprises a peripheral device display on which can present a graphical user interface that presents the third functionality to a user for selection.

As indicated above, claim 1 has been amended to incorporate the limitations from claim 3. Given that no new limitations have been presented to the Examiner for consideration, no new issues of patentability have been raised. Moreover, given that the amendment of claim 1 has resulted in the cancellation of claims 3 and 5, the amendment has reduced the number of issues for consideration on appeal. Applicant therefore respectfully submits that the amendment should be entered by the Examiner.

Turning to the merits of claim 1, Applicant notes that Casey does not teach first and second peripheral devices that are “coupled via a network”. Although Casey shows a network 400 that is connected to the adapter device 100 in Figure 1, the printer 200 and the image input device 300 communicate directly *via the adapter device*. As stated in the previous Response, although Casey’s peripheral devices may be considered to be indirectly connected to a network 400, they certainly are not coupled *to each other* “via a network.”

In regard to the Examiner’s comment in the Response to Arguments section of the Office Action that “both peripheral devices are linked to a network and therefore are connected to each other and the network,” such an arrangement does not equate to the two devices being connected to each other via the network.

Regarding dependent claim 8, Casey does not teach software components of first and second peripheral devices exchanging information "over a network" for reasons described above. In regard to the Examiner's comment in the Response to Arguments section that the network is accessed for software information, such an arrangement does not equate to the peripheral devices exchanging information with each other over a network as is clear from the context of claim 8.

## II. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

**A. Rejection of Claim 4**

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Casey in view of the "Wireless Networks" document ("the Wireless Networks document"). Applicant respectfully traverses this rejection.

As is identified above, Casey fails to teach explicit limitations of Applicant's claim 1. In that the Wireless Networks document does not remedy the deficiencies of the Casey reference, Applicant respectfully submits that claim 4, which depends from claim 1, is allowable for at least the same reasons that claim 1 is allowable over Casey. Applicant therefore requests that the rejection of claim 4 be withdrawn.

**B. Rejection of Claims 24-42**

Claims 24-42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Casey in view of *Brockway et al.* ("Brockway," U.S. Pat. No. 6,789,111). Applicant respectfully traverses this rejection.

## 1. Claims 24-42

Independent claims 24 and 32 provide as follows (emphasis added):

24. A method *practiced by a personal computer (PC)* for providing additional functionality from peripheral devices, the method comprising:

*searching for and identifying peripheral devices that are accessible to the PC;*

*determining the capabilities of each identified peripheral device using the PC; and*

presenting to the user with the PC a functionality that is available through combination of the capabilities of the identified peripheral devices, the functionality being a functionality that is not independently provided by the identified peripheral devices.

32. A *personal computer (PC)*, comprising:

a processor; and

memory comprising peripheral device software that is configured to *search for and identify peripheral devices, to determine the capabilities of each identified peripheral device using the PC, and to present to a user a functionality that is available through combination of the capabilities of the identified peripheral devices, the functionality being a functionality that is not independently provided by the identified peripheral devices.*

In regard to claims 24 and 32, the Examiner first argues that Casey teaches a "personal computer" that provides an addition functionality from peripheral devices. Applicant disagrees. Specifically, Casey never says that his "adapter device" comprises a "personal computer". Indeed, Casey actually explicitly teaches away from a personal computer by describing the adapter as a "relatively compact peripheral card device" in

column 4, line 65 to column 5, line 1 and by expressing the desirability of *not* having to use a host computer in column 5, lines 17-21.

In the Response to Arguments section of the Office Action, the Examiner states that the adapter actually is a personal computer (PC) because it comprises a processor and memory. In reply, Applicant submits that such an interpretation is clearly unwarranted. In particular, a person having ordinary skill in the art would not consider Casey's adapter as comprising a "PC" given that PCs are widely understood to be workstations or other "desktop" type computers, not peripheral card devices. Furthermore, a person having ordinary skill in the art would not consider Casey's adapter as comprising a "PC" given that Casey states that the adapter could be integrated into the scanner or camera 300. Clearly, an actual PC could not realistically be integrated into such devices.

The Examiner also argues that it would have been obvious to modify Casey's system to enable "searching for and identifying peripheral devices that are accessible to the PC" and "determining the capabilities of each identified peripheral device using the PC". Applicant disagrees. Although Brockway teaches automatic detection of peripheral devices with a computer for the purpose of installing driver software for the devices, Casey's "adapter device," which again is described at one point as being implemented as a "compact peripheral card device," is hardly equivalent to a computer. A person having ordinary skill in the art would not think to provide the detection functionality of Brockway's computer on Casey's adapter device. Indeed, it is unclear whether a simple "adapter device" such as that described by Casey could even be modified to provide such functionality. Applicant further notes that there is no motivation or suggestion provided by

the references to replace Casey's simple adapter device with a computer. Again, Casey teaches away from the need of a computer.

Moreover, Applicant notes that, contrary to that argued by the Examiner, Brockway does not teach "determining the capabilities of each identified peripheral device". Specifically, column 2, lines 16-24, which were identified by the Examiner, say nothing of peripheral device "capabilities." Instead, Brockway's computer merely identifies the "manufacturer and model number" of the peripheral device to enable selection of an appropriate driver. Therefore, there is absolutely no need in Brockway's system to determine the capabilities of the peripheral device because that information is simply not needed in selecting a driver for the peripheral device.

In the Response to Arguments section of the Office Action, the Examiner alleges that "Brockway discloses determining the capabilities of a peripheral device, which includes determining the appropriate driver that is capable of being used with the peripheral device." In reply, Applicant notes that the Examiner merely *presumes* that Brockway's system determines the capabilities of the peripheral device in selecting a driver and cites no portion of the Brockway reference for support. In reality, Brockway provides no such teaching or suggestion of determining the capabilities of a peripheral device. Applicant further notes that one cannot assume that a capability determination is made given that the "appropriate drivers" normally are selected simply based on the peripheral device make and model, just as described by Brockway.

As a further point, Applicant notes that Brockway's alleged teaching of "determining the capabilities" of a peripheral device for the purpose of selecting a driver does not provide a suggestion to "determine the capabilities" of peripheral devices for

the purpose of combining those capabilities to enable new capabilities as taught by Casey. Therefore, there is no legitimate motivation for incorporating Brockway's capability determination functionality into the Casey system.

For at least the foregoing reasons, Applicant submits that claims 24 and 32, and their dependents, are allowable over Casey/Brockway. Applicant therefore respectfully requests that the rejection as to claims 24-37 be overturned.

## 2. Claims 38-42

Independent claim 38 provides as follows (emphasis added):

38. A *peripheral device*, comprising:  
auto recognition logic that is configured to:  
*transmit a broadcast message on a network to announce the presence of the peripheral device on the network,*  
*receive response signals from compatible peripheral devices also on the network, the response signals comprising information as to the identity and capabilities of the compatible peripheral devices, and*  
*automatically present a functionality option to a user that is only available through combination of the capabilities of the peripheral device and at least one of the compatible peripheral devices.*

Regarding claim 38, the Examiner first argues that Casey teaches "a peripheral device" with capabilities to present a functionality option to a user that is only available through combination of the capabilities of the peripheral device and another peripheral device. Applicant disagrees. Again, Casey only teaches an "adapter device" that presents such a functionality, not a peripheral device.

Second, the Examiner argues that Brockway teaches receiving response signals from compatible peripheral devices on a network that comprise information as to the identity and "capabilities of the compatible peripheral devices". As described above, Brockway says nothing about obtaining information as to the "capabilities" of a peripheral device. Moreover, neither references teaches or suggests that such obtaining could be performed by a "peripheral device". Again, in Brockway's system, all information collected from peripheral devices is collected by a computer, not another peripheral device. In reply to the Examiner's allegation in the Response to Arguments section of the Office Action that "a computer can be interpreted as a peripheral device," Applicant asserts that a "device" peripheral clearly is not a "computer." Instead, as is well known to persons having ordinary skill in the art, a peripheral device is a device used *in conjunction with* a computer, hence the term "peripheral."

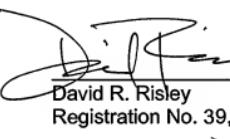
Applicant further notes that neither reference teaches a "peripheral device" that can "automatically present a functionality option to a user that is only available through combination of the capabilities of the peripheral device and at least one of the compatible peripheral devices", for reasons described above.

In view of the above, Applicant submits that claim 38, and its dependents, are allowable over Casey, and respectfully requests the rejection as to claims 38-42 be withdrawn.

**CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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David R. Risley  
Registration No. 39,345